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Dated: March 24, 2006

Signature:

*Norman Green*  
(Norman Green)

Docket No.: 564462000820 /  
D1180-2US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dan E. ROBERTSON et al.

Confirmation No.: 8980

Application No.: 09/903,410

Art Unit: 1652

Filed: July 10, 2001

Examiner: Rebecca E. Prouty

For: ENZYMES HAVING ESTERASE ACTIVITY  
AND METHODS OF USE THEREOF

**RENEWED PETITION TO ACCEPT  
UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY UNDER 35 U.S.C. § 365(c)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the DECISION ON PETITION (the "DECISION", copy attached) mailed May 28, 2004, received in connection with the subject application, from the OFFICE OF PETITIONS, dismissing Applicants' Petition submitted May 13, 2004, Applicants hereby renew their petition for entry of the enclosed amendment claiming benefit under 35 U.S.C. § 365(c) of International Application No. PCT/US97/02039, filed February 11, 1997 and published as WO 97/30160. The present application is directed to enzymes having esterase activity and methods of use thereof; aspects of this were described in International Application No. PCT/US97/02039. The applications contain at least one inventor in common and the PCT application discloses the invention claimed herein.

Applicants hereby state that the entire delay between the date the claim for benefit was due under 37 C.F.R. § 1.78(a)(5) and the date of the prior petition was unintentional.

Applicants therefore submit concurrently herewith a Substitute Amendment in compliance with the stated requirement of the DECISION. Entry of the Substitute Amendment and accordation of benefit are respectfully requested.

Applicants also submit concurrently a copy of Supplemental Application Data Sheet as filed with the prior Petition on May 13, 2004 which now properly compares with the amended Specification.

Applicants also request that an Updated Filing Receipt be issued containing the amendment to the Specification in the Substitute Amendment under the heading:

**"Domestic Priority data as claimed by applicant"**

No fee is believed to be due for this Renewed Petition, as the required fee was submitted with the previous Petition.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 564462000820.

Dated: March 24, 2006

Respectfully submitted,

By 

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UNITED STATES PATENT AND TRADEMARK OFFICE

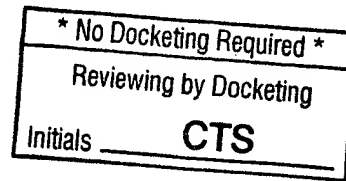
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OFFICE OF PETITIONS

In re Application of  
Dan E. Robertson et al  
Application No. 09/903,410  
Filed: July 10, 2001  
Attorney Docket No. 564462000820

:  
:  
: DECISION ON PETITION  
: UNDER 37 CFR 1.78(a)(3)  
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 17, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to the prior-filed PCT application set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in a concurrently filed amendment. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35

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U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See In re deSeversky, supra. Note also MPEP 201.06(c).

Additionally, the amendment filed with the instant petition do not compare with the application data sheet. It is not clear in the amendment what application is the PCT a continuation of, and the relationship of Application No. 09/382,242, to the instant application is not stated.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment<sup>1</sup> deleting the incorporation by reference statement to the prior-filed PCT application and correcting the above matter along with a renewed petition under 37 CFR 1.78(a)(3), is required.

As authorized, the \$1330 fee required by 37 CFR 1.78(a)(3)(ii) will be charged to petitioner's Deposit Account No. 03-1952.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop PETITIONS  
                                    Commissioner for Patents  
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<sup>1</sup> Note 37 CFR 1.121

By hand: Customer Window located at:

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ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8859.



Karen Creasy  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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## Supplemental Application Data Sheet

### Application Information

Application number::	09/903,410
Filing Date::	07/10/01
Application Type::	Regular
Subject Matter::	Utility
Suggested Group Art Unit::	1652
CD-ROM or CD-R?::	None
Sequence submission?::	None
Computer Readable Form (CRF)?::	No
Title::	ENZYMES HAVING ESTERASE ACTIVITY AND METHODS OF USE
Attorney Docket Number::	564462000820
Request for Early Publication?::	No
Request for Non-Publication?::	No
Small Entity?::	No
Petition included?::	Yes
Secrecy Order in Parent Appl.?::	No

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### Domestic Priority Information

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This Application	Continuation-in-part of	09/382,242	08/24/99
09/382,242	Continuation of	08/602,359	02/16/96
09/382,242	Continuation of	PCT/US97/02039	02/11/97

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